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DEC 30 2004

OFFICE OF PETITIONS

In re Application of
Downes, et al.

Application No.: 10/658,115

Filed: September 8, 2003

Attorney Docket No.: SALK3130-1(088802-9702)

For: NON-STEROIDAL FARNESOID X
RECEPTOR MODULATORS AND METHODS
FOR THE USE THEREFOR

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed October 25, 2004.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on September 8, 2003 without an executed declaration. On March 23, 2004, the Office mailed a Notice to File Missing Parts of Nonprovisional Application an executed oath/declaration and a surcharge for its late filing. In response, on June 28, 2004 (certificate of mailing date June 23, 2004), petitioners filed, *inter alia*, a declaration executed by 2 of 5 joint inventors, the surcharge, and a request for a one month extension of time and required fee. On July 16, 2004, the Office mailed a Notice of Incomplete Reply (Nonprovisional), that stated inventors Hughes, Nicolau, and Roecker had not signed the declaration and that the period to timely reply remained as set forth in the March 23, 2004 Notice.

In response, petitioners filed the instant Rule 47 petition with the required \$130 fee and a request for a five month extension of time with \$985, which is the balance due taking into consideration the one month extension of time purchased on June 28, 2004 (certificate of mailing date June 23, 2004). The petition is accompanied by a declaration by Attorney Sheila R. Kirschenbaum, who explains the non-signing inventors' attorney was mailed a copy of the application papers, but that

the non-signing inventors' attorney stated that his clients would not sign the enclosed declaration in a letter dated April 6, 2004.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks item (1) above.

As to item (1), Applicants have failed to establish that the inventors have refused to sign the declaration.

Attorney Sheila R. Kirschenbaum explains that a copy of the application as filed and the formal papers for signature were provided to Attorney Thomas Fitting, the legal representative for non-signing inventors Hughes, Nicolau, and Roecker. Attorney Kirschenbaum states that Attorney Fitting wrote a letter dated April 6, 2004 that acknowledged receipt of the application papers and stated that the inventors would not execute the declaration for patent application.

As stated in MPEP 409.03(d), "When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts."

Petitioners are requested to submit a copy of the April 6, 2004 letter in a reconsideration petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza 2, Lobby, Room 1B03
Arlington, VA 22202

By FAX: (703) 872-9306 – ATTN: Office of Petitions

Telephone inquiries should be directed to the undersigned at (571) 272-3230.

A handwritten signature in cursive script, appearing to read "E. Shirene Willis".

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions